

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MORENIKE AWOKOLA,
CARMEN FLOSBACH and
HELMUT LOFFLER

Appeal 2007-0296
Application 09/873,714
Technology Center 1700

Decided: July 30, 2007

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
CHARLES F. WARREN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the
final rejection of claims 1-3, 6, 8, 10, and 13. We have jurisdiction under
35 U.S.C. § 6.

We REVERSE.

The Appellants claim a process for repair coating of vehicle substrates which comprises applying to a metal substrate a filler coating composition which includes (A) a binder having free-radically polymerizable olefinic double bond(s), (B) a free-radically polymerizable reactive diluent comprising a (meth)acrylic acid ester formed by reacting (meth)acrylic acid with a cycloaliphatic alcohol, and (C) a compound having a phosphoric acid group and at least one free-radically polymerizable double bond. Further details regarding this claimed process are set forth in representative claims 1 and 8, which read as follows:

1. A process for repair coating of vehicle substrates which comprises:
 - a) applying a filler layer of a filler coating composition to a metal substrate,
 - b) curing the resultant filler layer by irradiations with high energy radiation and
 - c) applying a top coat layer to the cured filler layer and curing the top coat layer,

wherein the liquid filler coating composition comprises

(A) 15-60 weight-% of at least one free-radically polymerizable binder comprising at least one free-radically polymerizable olefinic double bond, said binder having fewer than three of said olefinic double bonds per molecule,

B) 40-85 weight-% of a free-radically polymerizable reactive diluent comprising at least one (meth)acrylic acid ester having an olefinic double bond, said at least one (meth)acrylic acid ester being formed by reacting (meth)acrylic acid with at least one cycloaliphatic alcohol, wherein the weight-% of components A) and B) adds up to 100 weight-%, and

C) 2-10 weight-% of at least one compound having at least one phosphoric acid group and containing at least one free-radically polymerizable double bond, wherein the weight-% of component C) is relative to quantity of the entire coating composition;

wherein said cured filler layer produces no edge marks when said topcoat layer is applied.

8. The process according to claim 1, wherein the filler coating composition comprises as component B) isobornyl (meth)acrylate.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

Richard	US 5,091,211	Feb. 25, 1992
Brehm	US 5,700,576	Dec. 23, 1997
Maag	US 6,531,188 B1	Mar. 11, 2003

Claims 1-3, 6, 10, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maag (i.e., DE-A-19757082 or WO 99/26733)¹ in view of Richard, and claim 8 is correspondingly rejected over these references and further in view of Brehm.

These rejections cannot be sustained for the reasons set forth below.

In rejecting claim 1, the Examiner concludes that it would have been obvious to modify Maag's process of applying a filler coating composition to a metal substrate by providing the composition with a phosphoric acid ester in order to improve bond strength as taught by Richard (Answer 3-4). We

¹ Concerning the disclosure of Maag, both the Examiner and the Appellants rely on and refer to Maag's English language disclosure in US 6,531,188 B1. We shall do likewise.

agree with Appellants, however, that Richard teaches using phosphoric acid esters to improve adhesion between vinyl resin layers (col. 1, ll. 6-9; col. 2, ll. 54-61) and not to a metal substrate as in claim 1 and Maag. While the disclosure at lines 55-60 in column 1 of Richard refers to providing strong adhesive bonds to metal substrates, we share the Appellants' view that this disclosure must be interpreted as relating to prior art compositions for the reasons fully detailed by Appellants (Br. 11-12; Reply Br. 4-5).

In the rejection of claim 1, the Examiner also concludes that Maag's disclosure of (meth)acrylic acid esters as a monounsaturated reactive diluent (col. 3, ll. 13-20) would have suggested the specific ester product formed by reacting (meth)acrylic acid with cycloaliphatic alcohol as claimed by Appellants. We disagree. Maag's non-categorical genus is evidentially inadequate to support this conclusion.²

This evidential inadequacy is not supplied by Brehm which is relied on for suggesting the specific cycloaliphatic-derived ester of claim 8, namely, isobornyl (meth)acrylate. While such an ester is used as a monofunctional reactive thinner in the composition of Brehm, this composition is for coating thermoplastic materials (col. 6, ll. 33-35) at thicknesses which must not exceed 50 microns in order to avoid cracking

² In an attempt to further support this conclusion of obviousness, the Examiner refers to a non-applied reference (i.e., US 6,340,733 to Stark et al.) in the "Response to Argument" section of the Answer (Answer 7). It is well established that such reliance on a non-applied reference is wholly improper. *In re Hock*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3; Manual of Patenting Examining Procedure (MPEP) § 706.02(j)(Rev. 5, Aug. 2006). Therefore, we have not considered this reference in our disposition of this appeal.

(para. bridging cols. 6-7). In contrast, Maag's process employs a composition for coating metal substrates (as required by the appealed claims) in order to obtain coating thicknesses of 200-400 microns (col. 6, ll. 33-41). In light of these contrasts, there would have been no motivation to use the isobornyl (meth)acrylate of Brehm in the composition of Maag based on a reasonable expectation of success.

Under the foregoing circumstances, we hereby reverse both of the Examiner's § 103 rejections of the appealed claims.

The decision of the Examiner is reversed.

REVERSED

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